

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1 and 27-36 are pending in the application, with claim 1 being the independent claim.

Applicants wish to thank Examiner Woitach for the telephone interview of July 28, 2005.

In the Office Action dated May 3, 2005, claims 1 and 27-36 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claim 1 of U.S. Patent No. 5,871,986.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider the outstanding rejection and that it be withdrawn.

Rejections under 35 U.S.C. § 102

Applicant thanks the Examiner for the withdrawal of the rejection of claims 1 and 27-36 in view of the outcome of Interference No. 104,570.

Double Patenting Rejection

The Office Action indicated that claims 1 and 27-36 are rejected under for obviousness-type double patenting over Claim 1 of U.S. Patent No. 5,871,986 [hereinafter "the '986 patent"]. In view of the telephone interview of July 28, 2005, Applicant submits that this rejection appears to be in error.

If it was the Examiner's intent to issue an obviousness-type double patenting over Claim 1 of the '986 patent, Applicant asserts that the finality of the Office Action is in error and should be withdrawn because a rejection over the '986 patent is a new rejection.

Additionally, the pending claims of the captioned application recite a method of expressing an exogenous gene in a mammalian cell, comprising introducing the cell into a mammal. In contrast, claim 1 of the '986 patent recites a method of expressing an exogenous gene in a mammalian cell *in vitro*. Thus, the claims of the captioned application do not constitute double patenting of claim 1 of the '986 patent.

Applicant understood from the telephone interview of July 28, 2005 that it was the Examiner's intent to issue a rejection of claims 1 and 27-36 under the judicially-created doctrine of obviousness-type double patenting over U.S. Patent No. 5,731,182 [hereinafter "the '182 patent"], as in the prior Office Action dated December 29, 2000. Applicant has expressed a willingness to file a terminal disclaimer over the '182 patent. (*See* Amendment and Reply Under C.F.R. § 1.111 filed June 29, 2001, page 12). Therefore, Applicant submits herewith a terminal disclaimer over the '182 patent. If, however, it was not the Examiner's intent to maintain the obviousness-type double patenting rejection over the '182 patent, then Applicant respectfully requests that the enclosed terminal disclaimer not be entered.

Conclusion

All of the stated grounds of the rejection have been properly accommodated. Applicant therefore respectfully requests that the Examiner reconsider the presently outstanding rejection and that it be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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